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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/576,800	05/23/00	CANNELL	D 05725.0572

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EXAMINER

FLOOD, M

ART UNIT	PAPER NUMBER
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1651

DATE MAILED:

10/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/576,800

Applicant(s)
CANNELL et al.

Examiner
Michele Flood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 10, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above, claim(s) 14-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Aug 10, 2001 is: a) ☐ approved b) ☒ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

This application contains claims 14-38 drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1-13 are under examination.

Response to Arguments

Applicant's arguments filed on August 10, 2001 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claims 1 and 10-12 remain rejected under 35 U.S.C. 102(b) as being anticipated by Ruiseco (A) or Konishi et al. (N). The claims remain rejected for the reasons set forth in the previous Office action and set forth below.

Applicant argues that Ruiseco does not discuss protection of keratinous fibers from extrinsic damage as defined in the present specification. However, Applicant's argument is neither persuasive nor commensurate in scope to the limitations of the claimed invention because Ruiseco teaches a method of treating dry scalp, dry skin conditions, and human hair by placing a hair treatment composition comprising a mixture of avocado extracts and arnica on the treatment area for a period of time and then shampooing it off (see ABSTRACT and Column 1, lines 58-68 to Column 2, lines 17). Applicant submits that Ruiseco does not identically describe a method of protecting keratinous fibers from extrinsic damage, however, Ruiseco does expressly teach a method of treating hair of patients undergoing radiation treatment for the prevention of hair loss.

Applicant argues that Konishi does not anticipate the claimed invention because no where in the disclosure can Applicant find reference a "method" of "protecting hair" and that Konishi merely provides a composition for promoting hair growth. However, this is not persuasive because Konishi, like the instantly claimed method, teaches a one-step process of applying to the hair an herbal hair tonic comprising an extract of mistletoe and an extract of *Angelic pubescens* Maxim., in a amount of 0.1 to 5% of the total dried material in the hair tonic composition. Konishi teaches that the hair tonic promotes hair growth without skin irritation. Furthermore, as

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Konishi teaches that the mistletoe alone has remarkable trichogenous effect, the method taught by Konishi is a method of protecting keratinous fiber from extrinsic damage.

Thus, the references of Ruiseco and Konishi claim the subject matter.

Claims 1-3, 7 and 9-11 remain rejected under 35 U.S.C. 102(e) as being anticipated by Bradbury et al. (D). The claims remain rejected for the reasons set forth in the previous Office action and set forth below.

Applicant argues that Bradbury does not identically describe or disclose the instantly claimed method because the method taught by Bradbury is directed to “regulating the growth and loss of hair”. However, Applicant’s argument is not persuasive because Bradbury teaches a method of topically applying to hair a composition comprising sucrose and willowherb (*Epilobium*). As the instantly claimed process is a one-step process of applying to the hair an extract comprising willowherb, and further comprising at least one sugar, the method taught by Bradbury anticipates a method of protecting keratinous fiber from extrinsic damage because the claimed functional effect of protecting hair from extrinsic damage is inherent to the method taught by Bradbury. The reference claims the subject matter.

Claims 1-4, 6-7 and 10-13 remain rejected under 35 U.S.C. 102(e) as being anticipated by Carson et al. (B). The claims remain rejected for the reasons set forth in the previous Office action and set forth below.

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Applicant argues that Carson does not identically describe or disclose the instantly claimed method because the method taught by Carson is directed to “delivering a lipophilic material to a microorganism or to a biological surface” or to “delivering an amphipathic compound” to the same. However, Applicant’s argument is not persuasive because Carson teaches a method of delivering a compositions for topical application to mammalian skin, hair or nails containing sugars and at least one plant extract. See Claims 1-4, 7, and 17-18. The compositions taught by Carson are oil-in-water emulsions containing an amphipathic compound which carries at the head end of its hydrophilic part a moiety recognized by adhesions of microorganism or on a biological surface. See Column 3, lines 8-44. In Column 4, lines 24-50, Carson teaches examples of amphipathic compounds comprising a biospecific sugar moiety, wherein the sugar moiety is either a monosaccharide, disaccharide or a polysaccharide. In Column 4, lines 52-68 bridging Column 5, lines 1-15, Carson teaches preferred amphipathic compounds incorporating β -D-galactose are aldobionamides, including lactobionamide and maltobionamide. The amphipathic compounds taught by Carson constitute from about 0.05% to about 10% by weight of the emulsion, and preferably 0.1% to 10% by weight of the emulsion. See Column 7, lines 39-46. In Column 7, lines 52 to Column 8, line 3, Carson teaches that the composition contains oil droplets which serve as a substrate for an amphipathic compound, and that the association of the oil droplet and amphipathic compound provides a multiple binding site for a microorganism or a biological surface. Suitable oils or lipophilic compounds taught by Carson include evening primrose (willow herb extract) and avocado oil. In Column 9, lines 36-54, Carson teaches that the amount of the

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lipophilic compound in the composition ranges from 0.01% to 10% by weight, preferably from about 0.1% to 3%. Carson further teaches that lipophilic compounds which serve more than one function, for example plant extracts with antimicrobial activity, can comprise 0.05% or 0.1% to 3.0% of the total composition. Lastly, Carson teaches that lipophilic materials may include skin anti-ageing compounds, skin conditioning compounds, vitamins, antimicrobials, and UV-absorbing materials, in Column 8, lines 54-59. The reference claims the subject matter.

Claims 1-3 and 10-13 remain rejected under 35 U.S.C. 102(e) as being anticipated by Tolpa et al. (D). The claims remain rejected for the reasons set forth in the previous Office action and set forth below.

Applicant argues that Tolpa does not identically describe or disclose the instantly claimed method because Tolpa does not disclose protection of keratinous fiber from extrinsic damage. Applicant further argues that the teachings of Tolpa are directed to a method of making peat-derived bioactive products, and that "the use of a hair balm comprising peat-derived product" for the prevention of excessive drying of the hair and skin is not taught by Tolpa. However, Applicant's arguments are not persuasive because Tolpa teaches a method of administering a composition comprising a peat-derived bioactive product and herb extract in the form of either a gel or an ointment. The composition contains the peat-derived product in an amount of 0.1-10% by weight, preferably 0.05-1.00%, and most preferably 0.05-0.10% by weight, wherein the peat-derived product primarily contains polysaccharides, and other mineral and organic compounds

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which have nourishing and stimulating effects on humans and mammals. See Column 3, line 18 to Column 4, line 10 and Column 14, lines 24-28. In Column 11, lines 9-40, Tolpa teaches that the use of a hair balm comprising peat-derived produce in an amount of 0.01%-1% by weight and herb extracts in an amount of 0.01-10% by weight, prevents excessive drying of the hair and skin. Tolpa further teaches that suitable herb extracts like camomile extract or wheat germ extract can be used in the making his compositions.

Full consideration was made to Applicant's argument that Tolpa discloses a hair balm recipe comprising "components preventing excessive drying of hair" in Column 11, line 11. However, Applicant's argument is not deemed persuasive because the instantly claimed method is directed to a method of protecting keratinous fiber from extrinsic damage comprising applying to said fiber a composition comprising at least one plant extract chosen from a potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract, and wherein the composition further comprises a sugar. Because Tolpa expressly teaches a one-step process of applying to keratinous fiber, namely hair, a composition comprising herbal wheat germ extract, and at least one sugar, a method of protecting keratinous fiber from extrinsic damage comprising applying to said keratinous fiber a composition comprising wheat germ extract and further comprising at least one sugar is inherent to the method taught by Tolpa. The reference claims the subject matter.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al. (B) or Tolpa et al. (C), in view of Ruiseco (A), and further in view of Konishi et al. (N).

The claims remain rejected for the reasons set forth in the previous Office action and set forth below.

Applicant's arguments have been fully considered but they are not deemed persuasive to be persuasive because the cited references provide the suggestions and motivation to the claimed invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary references of Carson and Tolpa were relied upon for the reasons set forth in the previous Office action and for the reasons set forth above. Because Carson and

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Tolpa taught the claimed method except for extracts of mistletoe or avocado, the secondary references of Ruiseco and Konishi were relied upon because each teaches the protective activity of the instantly claimed extracts on keratinous fiber.

Thus, with Carson and Tolpa providing the motivation to apply to keratinous fiber a composition comprising at least one plant extract, and further comprising at least one sugar, and with Ruiseco providing the motivation to apply to the hair avocado extract for treatment against extrinsic damage caused by the use of heart medication, and exposure to chemotherapy and radiation, and finally with Konishi disclosing a mistletoe comprising hair formulation with trichogenous effect which promotes hair growth without skin irritation, it would have been obvious to one of ordinary skill in the art at the time the invention was made and one would have had a reasonable expectation of success to substitute the plant extracts taught by Carson and Tolpa to provide the claimed invention because Ruiseco and Tolpa, respectively, teach the beneficial effects of incorporating extracts of avocado and mistletoe in the making of compositions, which are used in methods for the protection of keratinous fiber from extrinsic damage. Furthermore, Tolpa expressly teaches that the choice of the plant extract used in the method' composition for the protection of keratinous tissue depends on the desired target surface and the beneficial bioactivity exerted by the plant extract on the target surface. Thus, the instantly claimed method is no more than the mere combining of well-known and old ingredients used in known methods for their beneficial functional effect of protecting keratinous fiber from extrinsic

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damage, as disclosed by the cited references. Therefore, the invention as a whole was clearly prima facie obvious in the absence to the contrary.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

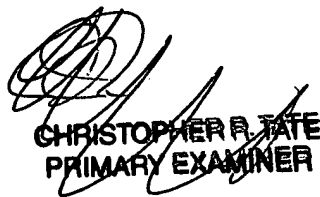
Claims 1-13 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/527,599. The rejection stands for the reasons set forth in the previous Office action and repeated below, as Applicant traverses the rejection without setting forth any substantial reasons for the traversal of the rejection.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are drawn to the use of identical or at least very similar ingredients to effect the same result or essentially the same result. Thus, the claims are obvious variants of each other

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claims are allowed.



CHRISTOPHER A. TATE
PRIMARY EXAMINER

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is (703) 308-9432. The examiner can normally be reached on Monday through Friday from 7:15 am to 3:45 pm. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196 or the Supervisory Patent Examiner, Michael Wityshyn whose telephone number is (703) 308-4743.

MCF

October 17, 2001


CHRISTOPHER R. TATE
PRIMARY EXAMINER